

REMARKS

Claims 1-49 were previously pending in the application.

Claims 5-28, 34-38, and 42-49 were previously withdrawn from consideration.

Claims 1-4, 29-33, and 39-41 have been rejected.

Claim 32 has been amended.

Claims 1-4, 29-33, and 39-41 remain pending in the application.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-4, 29-33, and 39-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,161,134 by Wang et al. ("*Wang*") or U.S. Patent No. 6,446,127 by Schuster et al. ("*Schuster*"). These rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant believes that *Schuster* is unavailable as prior art against the present application because *Schuster* has a filing date after the filing date of the present application. While *Schuster* is a continuation-in-part of a previously filed parent application, the Office Action fails to establish that

the material cited in *Schuster* is described in the parent application. As a result, *Schuster* is unavailable as “prior art” against the present application.

Regarding Claim 1, *Wang* recites an “information appliance” connected to a telephone or other communication device. (*Abstract*). The information appliance could represent a portable computer or a personal digital assistant. (*Figures 3A-3D*). Among other functions, the information appliance communicates with and establishes the operating parameters of the telephone. (*Col. 2, Lines 20-35*). The telephone may also communicate over a network with a router, gateway, gatekeeper, and directory server. (*Col. 10, Lines 32-40*).

Wang simply recites the use of a portable computer or other device coupled to a single telephone. As a result, the portable computer or other device of *Wang* fails to anticipate a call service provider that is “connected to a plurality of data network telephones” and that facilitates provision of telephony services for the “plurality of telephones” as recited in Claim 1.

For these reasons, *Wang* fails to anticipate the Applicant’s invention as recited in Claim 1 (and Claims 2-4 depending from Claim 1).

Regarding Claim 29, the Office Action asserts that the information appliance of *Wang* anticipates the “call service provider” recited in the claims. However, the cited portion of *Wang* fails to disclose that the information appliance determines whether the state of a telephone is incompatible with a requested function and provides the requested function if compatible. The cited portion of *Wang* therefore fails to anticipate that a “user input message is received” and that a “control message” is sent to a telephone to establish a service “if said state of said telephone is not

incompatible with said function” as recited in Claim 29. As a result, *Wang* fails to anticipate the Applicant’s invention as recited in Claim 29.

Regarding Claim 30, the cited portion of *Wang* fails to disclose setting up non-telephony data services during a call in response to commands from a telephone, where the data services do not conflict with the voice call. The cited portion of *Wang* therefore fails to anticipate receiving one or more user input messages “from said telephone ... during pendency of [a] voice call” and setting up “at least one non-telephony data service between said telephone and at least one data source,” where the “at least one data service does not conflict with said voice call” as recited in Claim 30. As a result, *Wang* fails to anticipate the Applicant’s invention as recited in Claim 30.

Regarding Claim 31, the cited portion of *Wang* fails to disclose that multiple data structures correlating input elements and telephone functions may be associated with a single telephone. The cited portion of *Wang* therefore fails to anticipate retrieving a “first configuration data structure” and a “second configuration data structure,” where each structure correlates “user input elements” of the telephone with “functions” of the telephone as recited in Claim 31. As a result, *Wang* fails to anticipate the Applicant’s invention as recited in Claim 31.

Regarding Claims 32 and 39, as described above, the cited portion of *Wang* fails to disclose a “call service provider” that is “connected to a plurality of data network telephones.” Also, because the information appliance of *Wang* is not coupled to a plurality of telephones, the information appliance does not anticipate a “control messenger” that can send messages to a plurality of

telephones as recited in Claims 32 and 39. As a result, *Wang* fails to anticipate the Applicant's invention as recited in Claims 32 and 39 (and Claims 40-41 depending from Claim 39).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-4, 29-33 and 39-41.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance and respectfully requests an early allowance of such claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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